

The Examiner also premised the rejection upon the limitation "a plurality of inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2", stating that the scope of the claim was uncertain since the cited regulation and rule may be subject to change and stating that the claim does not indicate which specific portions of the cited regulations and rules are included in the limitation of the claim.

Regarding the Examiner's contention that the claim does not indicate which specific portions of the cited regulations and rules are included in the limitation of the claim, Applicants respectfully disagree. The claim sets forth that the associated claim elements include "*a plurality of inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2*". In other words, it is the inspection sites from these references that are included in the associated claim element.

Moreover, "[b]readth is not to be equated with indefiniteness . . . ." (see, e.g., *In re Hyatt*, 708 F.2d 712, 714-15, 218 U.S.P.Q. (BNA) 195, 197 (Fed. Cir. 1983); *In re Miller*, 58 C.C.P.A. 1182, 441 F.2d 689, 693, 169 U.S.P.Q. (BNA) 597, 600 (CCPA 1971))(emphasis added).

Regarding the Examiner's statement that the scope of the claim was uncertain since the cited regulation and rule "may be subject to change" is respectfully traversed. Definiteness of claim language must be analyzed in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made (see, e.g., MPEP 35 § 2173.02). The essential inquiry is whether the claims set out and circumscribe a particular subject matter with a *reasonable degree* of clarity. If the claims, read in light of the specification, *reasonably* apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. § 112, second paragraph) demands no more. *Credle v. Bond*, 25 F.3d 1566 (Fed. Cir. 1994); *Shatterproof Glass Corp. v. Libbey*

*Owens Ford. Co.*, 758 F.2d 613 (Fed. Cir. 1985); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986)).

The claims relates to regulated and non-regulated tank cars and tie the list of sites to be inspected for such tank cars directly to a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2. One of ordinary skill in the art, at the time the invention was made, would immediately and unquestionably recognize the precise meaning and scope of each of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, which are references familiar to those of ordinary skill in the art. "[D]efiniteness of the language employed must be analyzed - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." *In re Angstadt*, 537 F.2d 498, 501 (CCPA 1976)(quoting *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971)).

That any of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2 "may change" in the future is irrelevant to the determination of indefiniteness, since such determination is properly pegged to the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art *at the time the invention was made* (see, e.g., MPEP § 2173.02).

Further, it is well settled that the initial burden of presenting a *prima facie* case of unpatentability, based on the prior art or any other ground, rests with the examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.1992). The only basis the examiner has presented to establish the indefiniteness of the claims is that the "cited regulation and rule may be subject to change". However, the examiner has not met the initial burden of establishing that one of ordinary skill in the art would not be apprised of the scope of the

language in question when read in light of the specification. See, e.g., *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994).

In view of the above, it is respectfully submitted that the claims reasonably comply with 35 U.S.C. § 112, second paragraph and that the Examiner has not set forth a legally sufficient *prima facie* case of indefiniteness. Reconsideration and withdrawal of this 35 U.S.C. § 112, second paragraph rejection is requested.

#### **THE 35 U.S.C. § 103 REJECTIONS**

Claims 1-3 and 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **McCasland** (U.S. Pat. No. 5,856,931). Reconsideration is requested.

---

Claim 1 (incorporating therein the limitations from claims 2-3) recites an inspection and requalification method comprising "selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, a comprehensive list of sites to be inspected for the selected type of vehicle . . . wherein said comprehensive list of sites to be inspected comprises a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said comprehensive list of sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2."

Claim 17 (incorporating therein the limitations from claims 18-19) recites an inspection and requalification procedure comprising compiling, for a list of vehicle types consisting of regulated tank cars and non-regulated tank cars, "a list of sites to be inspected, for each type and structure of the vehicle, . . . wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said

plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2".

Each of the rejected claims requires a list of sites to be inspected comprising "a plurality of inspection sites selected from each of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2". Thus, the claims require a list of sites to be inspection that comprises a combination inspection sites from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2 so as to align inspections for at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2. The claimed method permits, for example, "align[ment of] all inspection dates for all inspections by simultaneously performing all required procedures at once to minimize vehicle down time." (*see, e.g.*, page 12, line 24 to page 13, line 2)(parenthetical added for clarity). As disclosed, "[h]istorically, the industry has deferred tank car inspections and maintenance as long as possible to minimize and defer immediate expenditures" (*see* page 6, lines 3-15). Although in one respect this minimizes costs in the short-term, it is inefficient over longer time periods (e.g., 10 years)(*see id.*). The claimed method and procedure require that, for example, a plurality of inspection sites be selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, "so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2". Accordingly, the claimed method and procedure increases the interval between required inspections, thereby reducing overall (i.e., long-term) inspection costs (see page 6, lines 16-18).

**McCasland** teaches a process for identifying, scheduling, executing, analyzing and documenting inspection activities and does note applicability of the teachings therein generally to "railroad tanker cars" (col. 3, lines 3-4), **McCasland** fails to teach or suggest the claimed inspection and requalification method comprising "selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, a comprehensive list of

sites to be inspected for the selected type of vehicle . . . wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2" (claim 1).

**McCasland** also fails to teach or suggest a requalification procedure comprising compiling, for a list of vehicle types consisting of regulated tank cars and non-regulated tank cars, "a list of sites to be inspected, for each type and structure of the vehicle, . . . wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2" (claim 17).

Although one of ordinary skill in the art may possibly understand **McCasland** to relate to implementation of a specific inspection requirement (e.g., 49 C.F.R. § 180.509), there is absolutely no indication that **McCasland** teaches, suggests, or contemplates the *combination* of inspection requirements from multiple sources, as claimed, "so as to align inspections" from the multiple sources (e.g., "for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2"). Instead, **McCasland** adopts the conventional wisdom of deferring "inspections and maintenance as long as possible to minimize and defer immediate expenditures" (*see* page 6, lines 3-15). For example, **McCasland** notes with respect to a single inspection requirement (i.e., lubrication) "each individual item does not always have the same inspection frequency" and states that "if a machine has 20 lubrication points, all the points are not necessarily inspected at the same time" (col. 1, line 64 to col. 2, line 5). **McCasland** therefore provides a method and system for identifying, scheduling, executing, analyzing and documenting the inspection activities

completed and required, but does not seek to, for example, perform all of the lubrications, whether required or not, so as to realign the inspections (i.e., establish a new zero-time from which the permissible inspection intervals are measured) to minimize the machine's out of service time.

Accordingly, **McCasland** fails to teach or suggest each and every aspect of the claimed invention and reconsideration of this 35 U.S.C. § 103(a) rejection of claims 1-3 and 17-19 is requested.

Claims 4-16 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **McCasland** in view of 49 C.F.R. § 180.509. Reconsideration is requested.

Claims 4-16 and 20 further limit claims 1 and 17, respectively. Claims 4-16 recite an inspection and requalification method comprising "selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, a comprehensive list of sites to be inspected for the selected type of vehicle . . . wherein said comprehensive list of sites to be inspected comprises a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said comprehensive list of sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2."

Claim 20 recites an inspection and requalification procedure comprising compiling, for a list of vehicle types consisting of regulated tank cars and non-regulated tank cars, "a list of sites to be inspected, for each type and structure of the vehicle, . . . wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2".

As noted above, each of the rejected claims requires a list of sites to be inspected comprising "a plurality of inspection sites selected from each of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2". Thus, the claims require a list of sites to be inspection that comprises a combination inspection sites from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2 so as to align inspections for at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2. As also noted, the claimed method permits, for example, "align[ment of] all inspection dates for all inspections by simultaneously performing all required procedures at once to minimize vehicle down time." (*see, e.g.*, page 12, line 24 to page 13, line 2)(parenthetical added for clarity).

**McCasland** teaches a process for identifying, scheduling, executing, analyzing and documenting inspection activities and does note applicability of the teachings therein generally to "railroad tanker cars" (col. 3, lines 3-4), **McCasland** fails to teach or suggest the claimed inspection and requalification method comprising "selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, a comprehensive list of sites to be inspected for the selected type of vehicle . . . wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2". **McCasland** also fails to teach or suggest a requalification procedure comprising compiling, for a list of vehicle types consisting of regulated tank cars and non-regulated tank cars, "a list of sites to be inspected, for each type and structure of the vehicle, . . . wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2" (claim 17).

There is no indication that **McCasland** teaches, suggests, or contemplates the *combination* of inspection requirements from multiple sources, as claimed, "so as to align inspections" from the multiple sources (e.g., "for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2").

The Examiner cites 49 C.F.R. § 180.509 ("the Regulation") as including "the broad requirement to include any system or element that may effect safety" and relies upon this reading of 49 C.F.R. § 180.509 to justify extension of **McCasland** to encompass the claimed invention. This interpretation of 49 C.F.R. § 180.509 is not supported, as 49 C.F.R. § 180.509 sets forth broad minimal requirements for inspecting and testing tank cars, but does not "include any system or element that may effect safety". In fact, 49 C.F.R. § 180.509 does not set forth specifics even with respect to some of the mandated inspections. For example, even for lined tank cars transporting a material corrosive to the tank, "the owner of the lining or coating shall determine the periodic test interval, test technique, and acceptance criteria for the lining or coating" (see, 49 C.F.R. § 180.509(c)(3)(iii)(A)). Although 49 C.F.R. § 180.509 does set forth some inspection requirements, it does not include directly or by reference the inspection requirements of other sources, such as SSIP and Rule 88.B.2, and certainly does not mandate or suggest inclusion therein so as to align inspections, as claimed.

Accordingly, 49 C.F.R. § 180.509 does not teach or suggest "selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, a comprehensive list of sites to be inspected for the selected type of vehicle . . . wherein said comprehensive list of sites to be inspected comprises a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said comprehensive list of sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2" or "a list of sites to be inspected, for each



type and structure of the vehicle, . . . wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2", as claimed.

Accordingly, the combination of **McCasland** and 49 C.F.R. § 180.509 fail to teach or suggest each and every aspect of the claimed invention. Reconsideration of this 35 U.S.C. § 103(a) rejection is requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned VERSION WITH MARKINGS TO SHOW CHANGES MADE.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



William D. Pegg  
Registration No. 42,988

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 WDP:lmn/kap  
Facsimile: (202) 756-8087  
**Date: February 12, 2003**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Claims 2-3 and 18-19 without prejudice or disclaimer.

The claims have been amended as follows:

1. (Amended) For a wheeled vehicle adapted to transport commodities, an inspection and requalification method comprising:  
  
[determining] selecting for inspection [a type of vehicle under inspection comprises any] one of a regulated tank car and a non-regulated tank car;  
  
selecting from an instruction set [an exhaustive] comprising inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, a comprehensive list of sites to be inspected for the [identified] selected type of vehicle;  
  
inspecting each of the listed sites in accord with the instructions set forth for each of the listed sites in the instruction set; and  
  
recording data derived from implementation of the inspections conducted at each of said exhaustive list of sites,  
  
wherein said comprehensive list of sites to be inspected comprises a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said comprehensive list of sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2.

4. (Amended) For a wheeled vehicle adapted to transport commodities, an inspection and requalification method in accord with claim [3] 1, wherein the inspecting step includes a visual inspection of the tank shell interior and exterior; piping, valves, fittings and

gaskets; brake rigging, safety appliances, draft system, valves and fittings; closures and protective housings on the tank car; and all required markings on the tank car.

17. (Amended) An inspection and requalification procedure for a wheeled vehicle adapted to transport commodities, comprising: compiling (a) a list of vehicle types consisting of regulated tank cars and non-regulated tank cars, (b) [an exhaustive] a list of sites to be inspected, for each type and structure of the vehicle, and (c) a list of inspection procedures for each of the listed sites; and producing therefrom a report list for recording data derived from implementation of the tests conducted at each of said exhaustive list of sites, wherein the list of sites comprise a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, and wherein said plurality of inspection sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2.

---

20. (Amended) An inspection and requalification procedure for a wheeled vehicle adapted to transport commodities, in accord with claim [19] 17, wherein the [exhaustive] list of sites comprises:

- at least one pad-to-tank weld,
- at least one sill-to-pad weld,
- at least one bolster-to-bolster pad weld,
- at least one BOV saddle weld,
- at least one sump weld,
- at least one BOV skid weld,
- at least one attachment weld; and
- at least one draft pocket weld.